REMARKS

I. Introduction

Claims 12-14 remain pending in the present application and stand rejected. Reconsideration is requested in view of the following explanation.

II. Rejection of Claims 12-14 under 35 USC § 112

Claims 12-14 are rejected under 35 USC § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the Examiner contends that the limitation "**wherein in the case of the actual speed of the vehicle exceeding the predefined setpoint speed, preventing activation of the service brake if the actual speed of the vehicle exceeds the predefined setpoint speed by less than the first predefined speed difference**," is not described in the specification. However, Applicants respectfully submit that the claimed feature is clearly described in the specification.

On page 6, lines 12-22 of the Substitute specification, the following description is provided:

> In program point 185 vehicle control 10 ascertains **whether the actual speed exceeds the predefined setpoint speed by more than a first predefined speed difference**, which is greater than the sixth predefined speed difference. If this is the case, branching to a program point 190 will take place . . . . In program point 190, vehicle control 10 initiates an activation of service brake 1, whereupon the program branches to a program point 195.

Furthermore, page 9, lines 10-12 of the Substitute Specification explains that "[b]etween second time t_2 and a subsequent third time t_3, **difference v_act – v_setpoint** reaches a maximum value, which is **smaller than first predefined speed difference** KLDVBROB, however, **so that service brake 1 is not activated**."

Thus, in contrast to the Examiner's assertion, the claimed limitation "**wherein in the case of the actual speed of the vehicle exceeding the predefined setpoint speed,**

preventing activation of the service brake if the actual speed of the vehicle exceeds the predefined setpoint speed by less than the first predefined speed difference" is clearly described in the specification, and the 35 USC § 112, first paragraph, rejection should be withdrawn.

III. Rejection of Claims 12-14 under 35 U.S.C. § 102(b)

Claims 12-14 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,003,483 ("Hedstrom"). Applicants respectfully submit that the rejection of claims 12-14 should be withdrawn for at least the following reasons.

In order to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)). To the extent that the Examiner may be relying on the doctrine of inherent disclosure, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherence of that result or characteristic.

In support of the rejection, the Examiner contends on p. 3-4 of the Office Action that: a) Hedstrom teaches to activate the service brake in the event that the vehicle's current speed is greater than a setpoint speed in order to reduce the vehicle speed to the setpoint speed (citing column 1, lines 64 to 67; column 3, lines 24 to 29; and column 4, lines 3 to 8 of Hedstrom); and b) "in the case the deceleration exceeds defined limit value, which **inherently shows** the situation when the actual speed of the vehicle does not exceed a target value by a predefined speed difference, the brake application level can be adjusted downward," and "[t]his shows that when the actual speed of the vehicle does not exceed a

target value by a predefined speed difference, the activation of service brake application is **inherently prevented**." Applicants respectfully submit that the Examiner's contentions are legally and factually deficient, as explained in detail below.

First, the Examiner's explicit statement that "Hedstrom teaches to **activate the service brake in the event that the vehicle's current speed is greater than a setpoint speed** in order to reduce the vehicle speed to the setpoint speed" (citing column 1, lines 64 to 67; column 3, lines 24 to 29; and column 4, lines 3 to 8 of Hedstrom) clearly contradicts the claimed limitation that "**in the case of the actual speed of the vehicle exceeding the predefined setpoint speed, preventing activation of the service brake** if the actual speed of the vehicle exceeds the predefined setpoint speed by less than the first predefined speed difference." In Hedstrom, the disclosure is clear that the service is brake is activated in all cases in which **the vehicle's current speed is greater than a setpoint speed**; in the present claimed invention, activation of the service brake is prevented in certain situations even if the actual speed of the vehicle exceeds the setpoint speed.

With respect to the Examiner's "inherent disclosure" argument, in order to rely on the doctrine of inherent disclosure, the Examiner **must** provide a "basis in fact and/or technical reasoning to reasonably support the determination that the **allegedly inherent characteristics necessarily flow from the teachings of the applied art.**" (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). To the extent the Examiner contends that Hedstrom **inherently** teaches "that when the actual speed of the vehicle does not exceed a target value by a predefined speed difference, **the activation of service brake application is . . . prevented**," because Hedstrom allegedly teaches that "**in the case the deceleration exceeds defined limit value**, which **inherently shows** the situation when the actual speed of the vehicle does not exceed a target value by a predefined speed difference, **the brake application level can be adjusted downward**," there is simply no logical or factual basis to support the Examiner's conclusion that the **claimed limitations** are inherently disclosed, as explained below.

First, the Examiner is citing the alleged disclosure in Hedstrom regarding whether **the deceleration exceeds defined limit value**, which is completely independent of what actual speed currently prevails and which setpoint speed is currently predefined, and therefore there

is no logical basis to conclude that the deceleration exceeding the defined limit value in any way "**inherently shows** the situation when the actual speed of the vehicle does not exceed a target value by a predefined speed difference" as contended by the Examiner. In any case, whether **the deceleration exceeds defined limit value** has absolutely no logical relevance to the claimed limitation that "**in the case of the actual speed of the vehicle exceeding the predefined setpoint speed, preventing activation of the service brake** if the actual speed of the vehicle exceeds the predefined setpoint speed by less than the first predefined speed difference."

Second, even if one assumes for the sake of argument that Hedstrom discloses that the brake application level can be adjusted downward in the case **the deceleration exceeds the defined limit value**, Hedstrom clearly does not disclose or suggest at any point that it is even possible to **prevent an activation** of the service brake **when the actual speed exceeds the setpoint speed**; instead, Hedstrom merely indicates that the **brake application level be adjusted** within vehicle brake device 3 **in proportion to the exceeded setpoint value so that different levels of braking action are used in proportion to the extent to which the setpoint speed is exceeded** (column 4, lines 18 to 42, Hedstrom). This means that **when the actual speed exceeds the setpoint speed**, a level of braking action is activated **in all cases**, even if it is of varying strengths. In this regard, Hedstrom clearly does not disclose a speed region above the predefined setpoint speed, in which the secondary brake system **does not intervene at all**. Accordingly, there is no logical or factual basis to conclude that a **reduction of the braking action** disclosed in Hedstrom can be equated with the claimed **preventing of the activation of the service brake** as recited in claim 12, let alone provide a "basis in fact and/or technical reasoning to reasonably support the determination that" the claimed preventing of the activation of the service brake **necessarily has to occur**.

The conclusion that a **reduction of the braking action** disclosed in Hedstrom can not be equated with the claimed **preventing of the activation of the service brake** as recited in claim 12 is further supported by the fact that the brake control (with the aid of braking device 4) of Hedstrom is designed to decelerate the vehicle back to the setpoint speed when the actual speed exceeds the setpoint speed. If one were to **reduce the braking action in Hedstrom to zero** for actual speeds above the setpoint speed (which is what the Examiner is contending that Hedstrom inherently teaches), then it could be impossible to reach the

setpoint speed starting from the actual speed. For this additional reason, the reduction of the braking action disclosed in Hedstrom cannot be logically interpreted to mean that **for actual speeds above the setpoint speed, the activation of the service brake is prevented entirely**.

For at least the foregoing reasons, claim 12 and its dependent claims 13 and 14 are patentable over Hedstrom.

IV. Conclusion

In view of all of the above, it is respectfully submitted that all presently pending claims are in allowable condition.

Respectfully submitted,

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